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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,328	04/03/2001	Srinivas Gutta	US010164	1775
24737	7590	05/17/2005	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS				NGUYEN, DUC M
P.O. BOX 3001				ART UNIT
BRIARCLIFF MANOR, NY 10510				PAPER NUMBER
				2685

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/825,328	GUTTA ET AL.	
<b>Examiner</b>	<b>Art Unit</b>		
	Duc M. Nguyen	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 17 June 2004.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-39 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) \_\_\_\_\_ is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) 1-39 are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 06 August 2001 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is in response to applicant's response filed on 6/17/04. Claims 1-39 are now pending in the present application.

#### **Election/Restrictions**

1. Applicant's election with traverse of claims 1, 3-4, 11, 13-14, 21, 23-24, 31, 38-39 in the reply filed on 6/17/04 is acknowledged. Since the restriction in the previous Office Action is improper, a new restriction follows
  
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 11, 21, 31, 38-39 drawn to a method for recommending an item based on user's preferences under one or more environmental conditions, classified in class 705, subclasses 10, 26
  - II. Claims 2-4, 12-14, 22-24 drawn to a method for recommending a radio station, or content or product based on user's preferences under one or more environmental conditions, classified in class 705, subclasses 10, 26 and class 455, subclasses 3.01+, 432.3.
  - III. Claims 5-8, 15-18, 25-28, 32-35 drawn to a method for recommending an item based on different environmental conditions such as location, weather or user motion, classified in class 705, subclasses 10, 26.

IV. Claims 9-10, 19-20, 29-30, 36-37 drawn to a method for recommending an item based on preferences of a user profile, classified in class 705, subclasses 10, 26.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (group I) as claimed does not require the particulars of the subcombination as claimed because the combination has user preferences and environmental condition features that does not require the particulars of the subcombination as claimed for patentability. The subcombination has separate utility such as a radio station, a content or product.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2)

that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (group I) as claimed does not require the particulars of the subcombination as claimed because the combination has item recommendation and user preferences features that does not require the particulars of the subcombination as claimed for patentability. The subcombination has separate utility such as user location, weather or user motion conditions.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper.

5. The inventions are distinct, each from the other because of the following reasons:

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (group I) as claimed does not require the particulars of the subcombination as claimed because the combination has item recommendation and environmental condition features that does not require the particulars of the subcombination as claimed for patentability. The subcombination has separate utility such as preferences of a user profile.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group IV, restriction for examination purposes as indicated is proper.

6. The inventions are distinct, each from the other because of the following reasons:

Inventions II, III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as radio station, content or product while invention III has separate utility such as user location, weather or user motion, and invention IV has separate utility such as preferences of a user profile. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Groups III or IV, restriction for examination purposes as indicated is proper.

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**8. Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for formal communications intended for entry)  
(for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (571) 272-7893, Monday-Thursday (9:00 AM - 5:00 PM). Or to Edward Urban (Supervisor) whose telephone number is (571) 272-7899.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-7259.

Duc M. Nguyen  
May 12, 2005

